

### **REMARKS**

The Office Action of December 20, 2005 has been considered by the Applicants. Claims 1, 16, 17, and 26 have been amended. Claims 2, 9-12, 20, 21, and 23-25 have been cancelled. New claims 27-29 have been added. Claims 1, 3-8, 13-19, 22, and 26-29 are pending. Reconsideration of the Application is requested.

Restriction was required by the Examiner. As requested, Applicants affirm the election, with traverse, of Group I, i.e. claims 1-8 and 13-26. Claims 9-12 have been cancelled in this Amendment.

Due to the restriction requirement, a new title was requested that was descriptive of the invention to which the claims are directed. The specification has been amended to comply with this requirement.

Claim 23 was rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Scouten (US 4,076,641), Tyagi (US 6,156,473), or Quan (US 4,643,960). Applicants traverse the rejections. Without agreeing to these rejections and for the purposes of expediting examination, Applicants have cancelled claims 23-25. Therefore, this rejection is moot. Applicants request withdrawal of the 102(b) rejections.

Claims 1-4, 7, 13-16, 18-21, 23, 24, and 26 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Hamano (US 6,500,594), considered with Hara (US Appln. 2004/0192548). Applicants traverse the rejection.

Hamano discloses the use of an aliphatic acid amide as a releasing agent. Hamano contemplates and discloses only the use of primary monoamides, i.e. alkyl amides of the formula  $R'ONH_2$  (corresponding to the formula in claim 2). Applicants have amended claim 1 to include the subject matter of claim 2; however, R must be a hydrocarbon as well. In other words, primary monoamides are not claimed. Support for this limitation can be found in the specification in paragraphs 0015 and 0018 and in original claim 16. Hamano does not teach the use of secondary monoamides and thus does not anticipate the instant amended claims. Applicants request withdrawal of the 102(b) rejection.

Claims 1-4, 6-8, 13-16, 18-21, 23, 24, and 26 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Sacripante (US 6,140,003), in view of Hamano, in view of Hara. Applicants traverse the rejection.

This rejection is traversed on the same basis as Hamano and Hara. Neither reference discloses the use of a secondary monoamide. Sacripante does not remedy this deficiency either. Because not all claim limitations are met, the instant claims are not obvious over the cited references. MPEP § 2143.03. Applicants request withdrawal of the 103(a) rejection.

Claims 5, 17, 22, and 25 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Sacripante, Hamano, and Hara, in view of Minami (US 5,567,563). Applicants traverse the rejection.

There is no motivation to combine the references. Minami is cited by the Examiner as teaching that useful waxes for inclusion in toners as release agents include higher fatty acid amides of 10 to 70 carbon atoms, including stearyl erucamide. Minami discloses the combination of a binder resin (A) and an organic material (B), wherein the selected materials must satisfy the inequality  $4.0 \leq \Delta Sp + 1.2 \log M_B \leq 7.0$ ; see abstract. The purpose of the combination is to provide a toner having low MFT and high HOT; see col. 1, ll. 45-47. The higher fatty acid amides cited by the Examiner are described as the organic material (B), but the purpose of the organic material is never disclosed by Minami. Applicants are unable to find the teaching given by the Examiner in Minami, and the Examiner provided no citation to this teaching. Sacripante, Hamano, and Hara do not remedy this deficiency either.

Applicants also note that Minami requires that the inequality  $4.0 \leq \Delta Sp + 1.2 \log M_B \leq 7.0$  must be satisfied for Minami to be applied alone or as a primary reference. This inequality is not satisfied where the binder resin is a sulfopolyester resin as described in claim 7 and the organic material is stearyl erucamide or stearyl stearamide. Applicants, using the method described in The Polymer Handbook, 4<sup>th</sup> ed., ISBN 0-471-16628-6, calculate that the inequality is not met because  $\Delta Sp + 1.2 \log M_B$  is greater than 8.0. Applicants have added new claim 29, which recites these limitations. Support for this new claim can be found in the specification in paragraphs 0015 and 0019.

For these reasons, Applicants request withdrawal of the 103(a) rejection.

New claims 27 and 28 have been added. Support for these claims can be found in the specification in paragraph 0014.

Claims 7 and 26 were amended to clarify their meaning. These amendments do not change their scope and were not made for reasons of patentability.

Claim 16 was amended to maintain antecedent basis with claim 1.

Claim 17 was amended solely to correct a typographical error. This amendment does not change its scope and was not made for reasons of patentability.

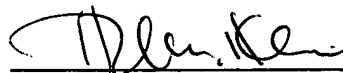
### **CONCLUSION**

For these reasons, the pending claims (1, 3-8, 13-19, 22, and 26-29) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,  
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